

REMARKS IN RESPONSE TO THE OFFICE ACTION:

ALLOWABLE SUBJECT MATTER

The Examiner now indicates that claims 3 and 21 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. Applicant appreciates the Examiner's acknowledgement of allowable subject matter. Claims 3 and 21 have been cancelled and new independent claims 34 and 35 have been added that incorporate the limitation requiring that the module include an arm inserted into a bore of the setting. Applicant respectfully requests that the Examiner indicate allowance of claims 34 and 35 in the next paper from the office.

Applicant traverses the rejection of independent claims 6 and 31-33. Examiner previously indicated that claims 13, 15, 19, and 29, if rewritten in independent form, were allowable. Applicant relied on Examiner's previous indication of allowable subject matter in amending independent claim 6 to incorporate limitations previously required by cancelled claim 13. Likewise, Applicant relied on Examiner's previous indication of allowability and cancelled claims 15, 19, and 29 while adding new independent claims 31-33, which represent cancelled claims 15, 19, and 29 rewritten in independent form. Applicant notes that "[g]reat care should be exercised" when rejecting a previously allowed claim. MPEP § 706.04. Applicant therefore respectfully requests that the Examiner indicate allowance of independent claims 6 and 31-33 in the next paper from the office. The remarks below further indicate why the Examiner's present position is improper.

REMARKS REGARDING AMENDMENTS

Claims 1, 5, 6, and 25 have been amended so that the scope and language of the claims is clearer and more precise in defining what the Applicant considers to be the invention for the purposes of appeal. Claims 34–35 have been added to incorporate the limitation required by previous claims 3 and 21. Claims 3 and 21 have been cancelled. Support for the above amendments can be found at least in the original specification, claims, and drawing as no new matter has been added. Applicant respectfully submits that the claims as amended are clearly distinct and patentable over the prior art of record and therefore respectfully requests that the Examiner enter these requested amendments and that all claims be allowed.

FIRST REJECTION UNDER 35 U.S.C. § 102(b):

Claims 1–2, 4–9, 11, 14, 16–18, 20, 22–28, 30 and 31 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,905,482 to Gheblikian (“Gheblikian”). Applicant requests that the Examiner reconsider and withdraw the above rejections in view of the foregoing amendments and the following remarks.

Gheblikian discloses a ring that includes a slot to hold a setting. The setting is held inside of the slot by a slidable door. Gheblikian does not disclose, teach, or suggest the “capture” module as required by the independent claims.

Claim 1 as amended requires that the module has two portions positioned adjacent to two portions of the setting to prevent the setting from escaping from the mounting area. As discussed above, Gheblikian discloses a slidable door that covers the opening of a slot designed to hold a setting. Gheblikian fails to teach a module that has two portions positioned adjacent to two portions of the setting. The door is only positioned adjacent to the portion of the setting closest

to the opening. For at least this reason, Applicant respectfully requests that the Examiner reconsider and withdraw the § 102(b) rejection of independent claim 1 as anticipated by Gheblikian.

Claims 2 and 5 depend from claim 1, and, thus, incorporate each limitation therein. Therefore, claims 2 and 5 are allowable for at least the same reason as independent claim 1. Applicant respectfully requests that the Examiner also reconsider and withdraw the § 102(b) rejection of claims 2 and 5 as anticipated by Gheblikian.

Claim 6 as amended requires that the module has at least two sides that define a capture area. As discussed above, Gheblikian discloses a slidable door that covers the opening of a slot designed to hold a setting. Gheblikian fails to teach a module that has at least two sides that define a capture area. For at least this reason, Applicant respectfully requests that the Examiner reconsider and withdraw the § 102(b) rejection of independent claim 1 as anticipated by Gheblikian.

Claims 7–9, 11, 14, 16–18, 20, and 22–24 depend from claim 6, and, thus, incorporate each limitation therein. Claims 7–9, 14, 16–18, and 20–24 are allowable for at least the same reason as independent claim 6. Additionally, claim 11 depends on dependent claim 10, and thus incorporates each limitation of claim 10. Claim 10 was not rejected over Gheblikian, and thus claim 11 is allowable over Gheblikian for the same reason as claim 10. Therefore, Applicant respectfully requests that the Examiner also reconsider and withdraw the § 102(b) rejection of claims 7–9, 11, 14, 16–18, 20 and 22–24 as anticipated by Gheblikian.

Independent claim 25 as amended requires means for holding a setting except substantially in both directions along one axis. As discussed above, Gheblikian discloses a ring

having a slot with an opening for holding a setting. This slot holds the setting exception substantially in only one direction along the axis of the slot. In other words, the setting may only fall out of the slot through the opening on one side of the ring. Thus, Gheblikian does not teach means for holding a setting except substantially in both directions along one axis. For at least this reason, Applicant respectfully requests that the Examiner reconsider and withdraw the § 102(b) rejection of independent claim 25 as anticipated by Gheblikian.

Claims 26–28 and 30 depend from claim 25 and, thus, incorporate each limitation therein. Claims 26–28 and 30 are allowable for at least the same reason as independent claim 25. Applicant respectfully requests that the Examiner also reconsider and withdraw the § 102(b) rejection of claims 26–28 and 30 as anticipated by Gheblikian.

Independent claim 31 requires a module discrete from the setting, wherein the module defines a slot coupling with a portion of a body, the body defining a mounting area. Further, the slot of the module must fit on a bridge of the body. As discussed above, Gheblikian discloses a door that covers the opening of a slot in a ring designed to hold a setting. The ring or body of Gheblikian may disclose a slot in the ring in which the door slides, but claim 31 requires that the module must define a slot for coupling with a portion of the body and that the slot **of the module** must fit onto the bridge of the body. The examiner identifies the slidable door as being the module. The door taught by Gheblikian does not have a slot as required by independent claim 31. For at least this reason, Applicant respectfully requests that the Examiner reconsider and withdraw the § 102(b) rejection of independent claim 31 as anticipated by Gheblikian.

SECOND REJECTION UNDER 35 U.S.C. § 102(b):

Claims 6 and 10 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Hendricks. The Examiner did not provide any further indication as to identity of the Hendricks reference. In the instance that Hendricks is U.S. Patent No. 5,228,317 to Hendricks (“Hendricks”), which was previously cited in a Dec. 22, 2004 Office Action, Applicant provides the following remarks. In any instance, Applicant respectfully requests the Examiner reconsider and withdraw the above rejections.

As discussed above, independent claim 6 as amended requires that the module has at least two sides that define a capture area. Additionally, claim 6 requires that the module slidably couple on the body. As previously addressed, Hendricks discloses a ring with interchangeable settings 20, 22 that are held in place within receiving hole 35 when shanks 23, 27 are rotated into engagement. Again the Examiner defines the “body” to be shank 23 and the “module” to be shank 27. Notably, these shanks are rotatably connected by pin 29. Hendricks neither discloses nor suggests the use of a module that is slidably coupled to the jewelry article to prevent the removal of the setting as recited in independent claim 6. Additionally, Hendricks neither discloses nor suggests a module that has at least two sides that define a capture area. Consequently, Hendricks fails to disclose or suggest all of the limitations of independent claim 6. For at least these reasons, Applicant respectfully requests that the Examiner reconsider and withdraw the § 102(b) rejection of independent claim 6 as anticipated by Hendricks.

Claims 10 depends from claim 6, and, thus, incorporates each limitation therein. Claim 10 is allowable for at least the same reasons as independent claim 6. Additionally, claim 10 depends on dependent claim 9, and thus incorporates each limitation of claim 9. Claim 9 was not

rejected over Hendricks, and thus claim 10 is allowable over Hendricks for the same reason as claim 9. Therefore, Applicant respectfully requests that the Examiner also reconsider and withdraw the § 102(b) rejection of claim 10 as anticipated by Hendricks.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 32 and 33 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gheblikian in view of U.S. Patent No. 6,715,315 to Hartgrove. Applicant requests that the Examiner reconsider and withdraw the above rejections in view of the following statement concerning common ownership.

STATEMENT CONCERNING COMMON OWNERSHIP:

U.S. Patent Application No. 10/649,309 and U.S. Patent No. 6,715,315 to Hartgrove were, at the time the invention of U.S. Patent Application No. 10/649,309 was made, owned by, or subject to an obligation of assignment to Heart & Company of 5622 Beverly Hill, Houston, Texas 77057. The assignment of U.S. Patent No. 6,715,315 to Heart & Company has been recorded with the United States Patent and Trademark Office at reel 013326, frame 0270. The assignment of pending U.S. Patent Application No. 10/649,309 to Heart & Company has been recorded with the United States Patent and Trademark Office at reel 014443, frame 0364.

Given the above, Applicant requests that the Examiner indicate the allowance of claims 1, 5–11, 14, 16–18, 20, 22–28, and 30–35 in the next paper from the Office. The Examiner is invited to contact the undersigned representative to discuss any issues or questions raised by this paper.

Serial No.: 10/649,309
Confirmation No.: 5404
Applicant: Ronald W. Hartgrove
Atty. Ref.: 11149.0030.NPUS00

Respectfully submitted,



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